



UNITED STATES PATENT AND TRADEMARK OFFICE

44
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,202	12/10/2001	Brian E. Springett	D/99720C	7306

7590 09/24/2003

Patent Documentation Center
Xerox Corporation
Xerox Square, 20th Floor
100 Clinton Ave. S.,
Rochester, NY 14644

EXAMINER

TRAN, HUAN HUU

ART UNIT PAPER NUMBER

2861

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
uspto.gov

M

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 9

Application Number: 10/010,202
Filing Date: December 10, 2001
Appellant(s): SPRINGETT ET AL.

Jerome D. Drabiak
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 03/27/2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or

Art Unit: 2861

have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1, 2, 4-6 and 8-10 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) ClaimsAppealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

WO97/21867

Franke

06/1997

Art Unit: 2861

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 4-6 and 8-10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Franke. This rejection is set forth in prior Office Action, Paper No. 6, dated 02/27/2003.

(11) Response to Argument

The claims presently before the Board of Patent Appeals and Interference, claims 1, 2, 4-6 and 8-10 are rejected under 35 USC 102(b) over Franke (WO 97/21867) for the reasons set forth at pages 2-3 of Paper Nos. 4 and 6. Essentially the elements of the claimed transfer sheet except the process step used to deposit the various layers of the transfer sheet are met by Franke. The Examiner has taken the position that the process used to deposit the various layers of the transfer sheet are not given patentable weight pursuant to the guideline set forth in MPEP 2113 with respect to product-by-process claims.

Appellants agree with the principle that "patentability is based on the product itself" but suggest that current case law stands for the proposition that the patentability of a product **does** depend on its method of production, citing Lexis headnotes 11-13 and that portion of the opinion associated with Lexis headnotes 11-13 in the case of Atlantic Thermoplastics v. Faytex, 970 F.2d 834; 1992 U.S. App. LEXIS 15888; 23 USPQ2d 1481 (Fed. Cir., 1992). The Examiner respectfully disagrees with this suggestion as the headnotes 11-13 of Atlantic Thermoplastics v. Faytex clearly suggest that the process limits a product-by-process claim **only in reviewing for infringement**. As a matter of fact, Lexis headnote 10 -and that portion of the opinion associated with it - of the cited case law clearly states: "A patent applicant **cannot** obtain

Art Unit: 2861

exclusive rights to a product in the prior art by adding a process limitation to the product claim. A new process, although eligible for a process patent, cannot capture exclusive rights to a product already in the prior art."

Further argument is made that anticipation under 35 USC 102 requires the presence in a single prior art disclosure of each and every element of a claimed invention, citing Lexis headnote 1 and that portion of the of the opinion associated with Lexis headnote 1 in the case of Lewmar Marine Inc. v. Barient Inc. (CA FC) 3 USPQ2d 1766. It is argued that since product-by-process claims are limited by and defined by the process, it therefore logically follows that Franke may **not** properly be cited as a 35 USC 102 reference against Applicant's claims, if the claims presently before the Examiner disclose a process limitation **not** disclosed in Franke. The Examiner respectfully disagree with this argument again for the reason that the it is well settled that **patentability** of a product does **not** depend on its method of production. See Lexis headnotes 1 and 2 and that portion of the opinion associated with headnotes 1 and 2 in the case of In re Thorpe, et al., 227 USPQ 964 (CA FC 1985) cited in MPEP 2113.

A further argument is made that it is not possible to define the characteristics which make claims 1, 2, 4-6 and 8-10 inventive over the prior art **except by referring to the process**, referring to Atlantic Thermoplastics v. Faytex, 970 F.2d 834; 1992 U.S. App. LEXIS 15888; 23 USPQ2d 1481 (Fed. Cir., 1992) where is is stated that: "the rule is well established that where one has produced an article in which invention rests over prior art articles, and where it is not possible to define the characteristics which makes it inventive except by referring to the process by which the article is made, he is permitted to so claim his article, but is limited in his protection to articles produced by his method referred to in the claims." In this regard

Art Unit: 2861

the Appellant has **failed** to present any convincing argument that the process step in the claimed product imparts distinctive structural characteristics to the final product. See MPEP 2113, citing, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) (holding "interbonded by interfusion" to limit structure of the claimed composite and noting that terms such as "welded," "intermixed," "ground in place," "press fitted," and "etched" are capable of construction as structural limitations.)

For the reasons given above, it is respectfully submitted that the Examiner's analysis and application of prior art in a **patentability** determination should be maintained.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Huan H. Tran
Primary Examiner
Art Unit 2861

hht
September 17, 2003

Conferees
Benjamin Fuller, SPE AU 2861
Olik Chaudhuri, SPE AU 2823

Patent Documentation Center
Xerox Corporation
Xerox Square, 20th Floor
100 Clinton Ave. S.,
Rochester, NY 14644